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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,570	12/17/2001	Sharon Schwartz	P00021902X	2702

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EXAMINER

PERRIN, JOSEPH L

ART UNIT	PAPER NUMBER
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1746

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,570

Applicant(s)

SCHWARTZ, SHARON

Examiner

Joseph L. Perrin, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 10-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I in the reply filed on 02 August 2004 is acknowledged. The traversal is on the ground(s) that the use of the device for painting or coating is not the intent of Applicant's invention. This is not found persuasive because the invention as claimed could be used to practice such materially different methods.
2. The requirement is still deemed proper and is therefore made FINAL.
3. This application contains claims 10-15 drawn to an invention nonelected with traverse in the Amendment filed 02 August 2004. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Response to Arguments

4. In view of applicant's amendment filed 02 August 2004, the status of the application is as follows:

Drawings Objections

The drawing correction has been approved by the Examiner.

Specification Objections

The objections of the specification for minor formalities have been withdrawn in view of the aforementioned amendment.

Claims Objections

The objection of claim 6 is withdrawn in view of the aforementioned amendment.

35 U.S.C. §112, second paragraph Rejections

The rejection of claims 2-3 and 5-9 are withdrawn in view of the aforementioned amendment.

35 U.S.C. §102(b) Rejections over Nygren

The rejection of claims 1-5 and 7-9 are maintained for reasons set forth below.

In response to applicant's argument that "Nygren is not capable of functioning the same as this invention", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In the instant case, applicant argues the functioning of the present invention versus the functioning of Nygren, notwithstanding the fact that the apparatus of Nygren reads on the claimed structural limitations of applicant's invention. The flexible hoses of Nygren include an end portion, even though it's connectible to a paint spray gun, reads on the broadly claimed "nozzle aligned...such that an internal channel in the object is flushed with cleaning fluids". It is further noted that how the nozzle is "aligned" and whether or not the object to be cleaned is "disassembled" is intended use and given little patentable weight. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (emphasis in original) Moreover, Applicant's "whereby" clause in claim 1 is considered intended use since the clause recites the operation of the apparatus and fails to further structurally limit the claimed apparatus. It has been held that the functional "whereby" statement does not define any structure and accordingly can not serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

In addition, applicant argues that "Nygren does not disclose each and every element of this invention" and that Nygren does not disclose the claimed holding device. This is not persuasive because applicant's

arguments are not directed to the broadly claimed subject matter, namely "holding devices", but rather to intended use of how and what the holding device holds. Accordingly, since Nygren discloses each and every structural limitation of applicant's claimed invention, and the structural limitations of Nygren are fully capable of performing the intended use recitations of the claimed invention, Nygren reads on applicant's claimed apparatus.

Claim Rejections - 35 USC § 102

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated US 5,937,875 by Nygren.

Re claims 1-3, Nygren discloses an apparatus having a basin 110, a plurality of supply nozzles (nozzles 74 & 76) connected to a supply line 60, a plurality of holding devices (clips 98 connected to removable rack 20), a plurality of cleaning nozzles attached to a plurality of flexible extension tubes (which are connected to the supply line), the flexible tubes being construed as adjustable tubes (cleaning nozzles being end adapters 82/84 located on flexible tubes 78 which are aligned with the holding device via connection to the object to be held) (see entire reference of Nygren, specifically Figure 2; col. 2, lines 30-46; col. 3, lines 10-25).

It is noted that how the flexible extension tubes are adjustably aligned is considered intended use and given little patentable weight in apparatus claims. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (emphasis in original) Moreover, Applicant's "whereby" clause in claim 1 is considered intended use since the clause recites the operation of the apparatus and fails to further structurally limit the claimed apparatus. It has been held that the functional "whereby" statement does not define any structure and accordingly cannot serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

Re independent claim 4, Applicant claims a "kit". It is noted that the recitation of "for attachment to cleaning machines" in independent claim 4 has not been given significant patentable weight because the recitation occurs in the preamble. A preamble is generally accorded little patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). It is further noted that Merriam-

Webster (<http://www.merriamwebster.com>) defines of a kit as being "a group of persons or things", and thus, claims 4-5 and 7-9 will be examined accordingly.

Re claims 4-6 & 8-9, Nygren discloses a group of structures including a plurality of holding devices (clips 98 connected to removable rack 20), a plurality of cleaning nozzles attached to a plurality of flexible extension tubes which are fed from solvent supply (manifold 60), the flexible extension tubes being equivalent to means to adjustably align (cleaning nozzles being end adapters 82/84 located on flexible tubes 78 which are aligned with the holding device via connection to the object to be held) (see entire reference of Nygren, specifically Figure 2; col. 2, lines 30-46; col. 3, lines 10-25).

As previously noted, the recitations of how the flexible extension tubes are adjustably aligned, and furthermore whether or not flow direction "can be altered" is considered intended use and given little patentable weight in apparatus claims.

Re claim 7, Nygren discloses a plurality of brackets (see support rack 20 having four vertical members 50 and horizontal members 52/54/52, Figures 2 & 3) which, in view of the Figures 2 & 3, inherently must attach to the solvent supply 60 and, as a result, extension tubes 78 with cleaning nozzles due to the interwoven relationship between solvent supply manifold 60 and support rack 20 including vertical members 50, horizontal members 52/54 and ring members 46/48.

Accordingly, recitation of Nygren reads on applicant's claimed invention.

Conclusion


7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
8. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: U.S. Patent No. 6,554,009 to Beijbom *et al.*, which discloses a spraygun washing apparatus including flexible hoses with nozzles; U.S. Patent No. 5,485,860 to Robb *et al.*, which discloses a spraygun cleaning apparatus with multiple hoses with nozzles.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph L. Perrin, Ph.D. whose telephone number is (571)272-1305. The examiner can normally be reached on M-F 7:00-4:30, except alternate Fridays.
11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael E. Barr can be reached on (571)272-1414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph L. Perrin, Ph.D.
Examiner
Art Unit 1746

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